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PATENT
9008-1004

IN THE U.S. PATENT AND TRADEMARK OFFICE

In re application of

Paul ROSS et al.

Conf. 8808

Application No. 10/576,010

Group 1632

Filed April 17, 2006

Attn: Erin P. Thomson
Attorney Advisor
PCT Legal Admin.

USE OF PROBIOTIC BACTERIA IN THE TREATMENT OF
INFECTION

RENEWED PETITION UNDER 37 CFR §1.47(a)

Assistant Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

March 20, 2008

Sir:

In response to the Decision on Petition mailed October 22, 2007, applicant hereby renews its petition under Rule 47(a) to accept the present application in the absence of a non-signing inventor.

Applicant hereby reincorporates the allegations made in and the Declaration of Christina Gates attached to the Petition Under 37 CFR § 1.47(a) filed August 6, 2007.

Applicant notes with appreciation the indication in the October 22, 2007 Decision that the first and fourth requirements of Rule 47(a) have been met by the initial petition of August 6, 2007.

The October 22, 2007 Decision (hereafter, "the Decision") contends that the original petition was dismissed on two grounds: (i) that the petition did not adequately demonstrate that the nonsigning inventor was presented with a complete copy of the application papers; and (ii) that the petition lacked a statement of the nonsigning inventor's last known home address.

We address each of the two points raised by the Decision in reverse order.

The Decision states that the third requirement of Rule 47(a) requires a statement of the nonsigning inventor's last known home address. However, we note that Rule 47(a) actually requires "the last known address", without distinguishing between a home or business address. Moreover, MPEP § 409.03(e) states that, "[t]hat address should be the last known address at which the inventor customarily receives mail." (citing MPEP § 605.03). Section 605.03 in turn states that in determining which address an applicant customarily receives mail, "[e]ither applicant's home or business address is acceptable as the mailing address."

Thus, MPEP §§ 409.03(e) and 605.03 taken together state that the third requirement of Rule 47(a) is satisfied by providing the nonsigning inventor's last known home or business address.

Notwithstanding that clear instruction, MPEP § 605.03 includes the apparently contradictory statement that in an application filed under Rule 47, the inventor's most recent home address must be given. However, § 605.03 also explains that the

purpose of providing the nonsigning inventor's address is to "enable the Office to communicate directly with the inventor as necessary," and that that purpose is accomplished by providing each applicant's "mailing address," which mailing address may be "[e]ither applicant's home or business address."

Accordingly, applicant considers that the original petition, which provided the nonsigning inventor's last known business address, fully satisfied the third requirement of Rule 47(a).

In any event, the last known home address of the non-signing inventor, Mr. Stephen Hallahan is:

Cois Abhann, Calbridge,
County Kildare,
Calbridge, IRELAND.

That home address is evidenced by two separate Declarations executed and submitted to the PTO pursuant to 37 CFR § 1.63 by Mr. Hallahan - specifically, in Application Serial Nos. 10/237,788 and 11/607,033. Copies of the foregoing Declarations, which indicate Mr. Hallahan's last known home address, are attached hereto.

As to the second requirement of 37 CFR 1.47(a), the Decision states that the application papers sent to the non-signing inventor "have to reach the inventor to establish refusal."

For the following reasons, applicant respectfully disagrees.

First, neither Rule 47(a) nor the relevant sections of the MPEP impose a requirement that the nonsigning inventor actually receive in-hand the delivered application papers. Rule 47(a) states in pertinent part that it applies "[i]f a joint inventor refuses to join in an application." MPEP § 409.03(d)(II), which identifies possible means of proof of such refusal, states only that the inventor must be "presented with the application papers," which according to that same section of the MPEP is accomplished by sending a copy of the application papers "to the last known address of the nonsigning inventor." Notably, MPEP § 409.03(d)(II) explicitly acknowledges that a *bona fide* attempt to present the application papers, but where the nonsigning inventor refused to accept delivery, may be sufficient.

The original petition includes the Declaration of Dr. Christina Gates, the Managing Partner of Tomkins & Company, European Patent Attorneys, who has firsthand knowledge of the facts surrounding applicant's *bona fide* attempt to present Mr. Hallahan with the application papers and Mr. Hallahan's refusal to execute them. That Declaration includes documentary evidence that the application papers were successfully delivered to the attention of Mr. Hallahan at his known business address. Whether Mr. Hallahan refused delivery from his office or refused to execute and return the application papers is irrelevant to applicant's showing that it made the necessary presentation in compliance with Rule 47(a).

The Decision faults the original petition for allegedly failing to state that applicant verified Mr. Hallahan's business address. To the contrary, the Declaration of Dr. Gates specifically states that a meeting was held with Cross VetPharm Ltd., that Cross VetPharm Ltd.'s employee Mr. Hallahan was identified at that meeting as a co-inventor, and that the application papers were delivered to Mr. Hallahan's attention at his employer Cross VetPharm Ltd.

Applicant submits herewith a second Declaration of Dr. Christina Gates in further support of the fact that applicant verified Mr. Hallahan's business address. Specifically, in the attached second Declaration, Dr. Gates confirms that she received a letter from Cross VetPharm Ltd. stating that Cross VetPharm Ltd. had requested Mr. Hallahan to sign a power of attorney regarding this application. A redacted copy of that letter is attached to Dr. Gates' second Declaration. That copy also indicates that the letter from Cross VetPharm Ltd. was sent July 23, 2007, in response to a letter request from Dr. Gates dated June 15, 2007, both of which therefore occurred at approximately the same time as the application papers were sent to Mr. Hallahan on June 19, 2007 at his Cross VetPharm Ltd. business address. Accordingly, Dr. Gates' second Declaration and the letter attached thereto unequivocally show that Dr. Gates, acting on behalf of applicant, received verification that Mr. Hallahan was at that time employed by Cross VetPharm Ltd.

and in fact received mail correspondence at that business address.

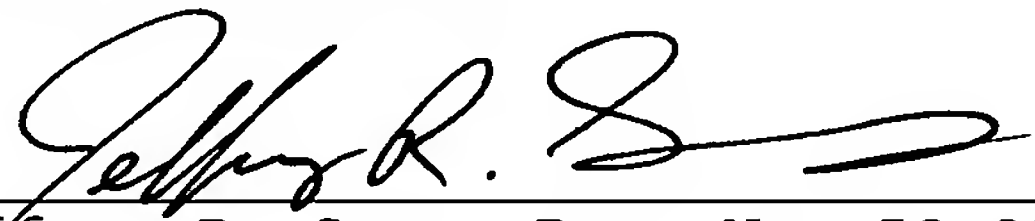
Additionally, Rule 47(a) encompasses a second basis for filing an application despite a nonsigning inventor - specifically, where that inventor "cannot be found or reached after diligent effort."

Thus, even if Mr. Hallahan had not received in-hand the application papers that were successfully delivered to his known business address, that would merely evidence applicant's failure to find or reach the nonsigning inventor after diligent effort.

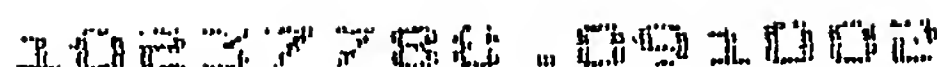
In view of the above facts, and accompanying supporting documents, it is respectfully requested that the above-identified application be accepted under the provisions of 37 CFR 1.47(a) even though the second listed inventor has refused to execute the application papers.

Respectfully submitted,

YOUNG & THOMPSON



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209 Madison Street, Suite 500
Alexandria, VA 22314
Telephone (703) 521-2297
Telefax (703) 685-0573
(703) 979-4709



FOR ATTORNEY'S USE ONLY
ATTORNEY'S DOCKET NO.

As a below named inventory, I declare that my maidenname, maiden name surname and children are stated below next to my name, the information given herein is true that I possess that I am not married, but not born married (if they were married in 2011 below), of a first and last name in (a) child name(s) (a) married below = 2011 ID, as an additional names attached herein) at the current number which is indicated on the birth certificate is indicated on the current birth certificate.

A Biosecurity system

PCT International Application No.

Used

the application is application Serial
No

Index

(If applicable) and
 prepared on

I hereby state that I have reviewed and understand the contents of the above identified specification, including the claims, as amended by any amendments I have made to the specification and I am aware of the legal consequences of the filing of this specification and I am aware of the legal consequences of the filing of this specification and I am aware of the legal consequences of the filing of this specification.

I hereby claim foreign priority benefits under Title 35, United States Code, 3113 (a)-(4) of any foreign application(s) for claims of inventor(s) designated herein under this patent which benefits include any foreign application(s) having a filing date earlier than all the corresponding claims herein priority is claimed.

Prior Foreign Application(s)

(Name)

(LAWYER)

(U.S.G.P./ASST. ATTY GEN. F-40-1)

History & Geography

□

5

(NUTROG)

(1200000)

ILLUSTRATION OF FINDS

20

1045

(Polymer Name)

(Kendall)

Umsatzsteuern

1

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I hereby certify the contents under TUSA 34 - Fraud Section (Case, D 1124) as being a true and correct reproduction of the original document.

Application No 60/317,934

1 And Last September 10, 2001 Application No.

Future studies

I hereby claim the benefit under Title 35, United States Code, § 101, as may be amended herein, application(s) set forth below and, except for the subject matter of each of the Claims of the above-referenced PCT application or the prior filed United States application in the manner provided by the first paragraph of 35 U.S.C., United States Code, § 112, a acknowledgment that such disclosure information which is contained in or derivable from documents as defined in 35 U.S.C., Code of Federal Regulations, § 1.56, which are made available between the filing date of the present application and the national or PCT examination filing date of this Application:

Fig. 1

Application Control

(Filing Date)

(Please do not write on this page)

POWER OF ATTORNEY: As a named inventor, I hereby appoint the following attorneys (Registration No.) to prosecute this application, receive and act on instructions from my agent and transact all business in the Patent and Trademark Office connected therewith. HARVEY B. JACOBSON JR. (20,851); D. DOUGLAS TUNICE (24,514); JOHN C. ARKE HOE MAN (22,700); MARVIN R. STERN (20,840); MICHAEL R. SLOBASKY (26,421); JONATHAN L. SCHERER (20,851); IRWIN M. AISENBERG (10,007); WILLIAM E. FLAYER (11,409)

SEND CORRESPONDENCE TO:

JACOBSON, PRICE, HOLMAN & STERN
PROFESSIONAL LIMITED LIABILITY COMPANY
400 SEVENTH STREET N.W.
WASHINGTON, DC. 20004

DIRECT TELEPHONE CALLS 10

(RETURN TO THE ATTORNEY GENERAL'S OFFICE) (202) 633-1641

JACOBSON, PRICE, HOLMAN & STERN
PROFESSIONAL LIMITED LIABILITY COMPANY

1. REDACTED

201	FULL NAME OF INVENTOR *	FAMILY NAME McHardy	GIVEN NAME Nicholas	MIDDLE NAME
	RESIDENCE & CITIZENSHIP	CITY Baltyboys	STATE OR FOREIGN COUNTRY Ireland	COUNTRY OF CITIZENSHIP United Kingdom
	POST OFFICE ADDRESS	POST OFFICE ADDRESS Baltyboys, County Wicklow	CITY Baltyboys	STATE OR COUNTRY Ireland
202	FULL NAME OF INVENTOR *	FAMILY NAME Hallahan	GIVEN NAME Stephen	MIDDLE NAME
	RESIDENCE & CITIZENSHIP	CITY Celbridge	STATE OR FOREIGN COUNTRY Ireland	COUNTRY OF CITIZENSHIP Ireland
	POST OFFICE ADDRESS	POST OFFICE ADDRESS Cois Abhainn, Celbridge, County Kildare	CITY Celbridge	STATE OR COUNTRY Ireland
<p>I hereby declare that all of the foregoing made known to my own knowledge and true and that all customers made on information and belief are believed to be true, and further that these statements were made with the intention that they be used in the making of the patent application and that such would take statements they represented the verity of the application as set forth herein. Name(s):</p>				
SIGNATURE OF INVENTOR 201		SIGNATURE OF INVENTOR 202		SIGNATURE OF INVENTOR 201
DATE 05.09.02		DATE 01/9/02		DATE

Additional inventors are named on separately numbered sheets attached hereto.



Declaration

I, Christina Gates, Managing Partner of Tomkins & Company, European Patent Attorneys, make this declaration.

I am the Patent Attorney responsible for preparing and drafting Irish Patent Application No.2003/0773 entitled "Use of Probiotic Bacteria in the Treatment of Infection". This is the priority application on which U.S. Patent Application Serial No. 10/576,010, which is the national stage of PCT/IE2004/000143.

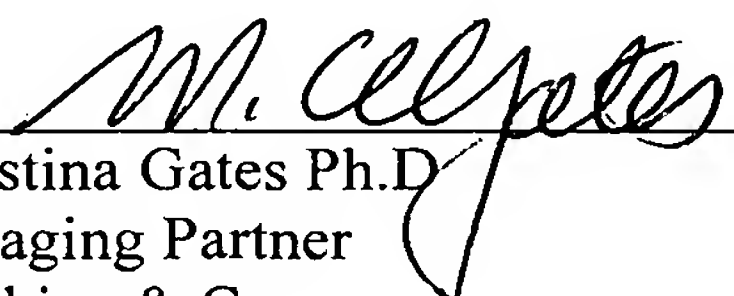
The invention arises out of collaborative research conducted between Teagasc, the Agricultural & Food Development authority, University College Cork, and a company, Cross VetPharm Limited. At a meeting between representatives of these parties, inventorship of the invention was determined, and a verbal agreement made for assignment of rights between the various parties.

Further to my declaration of 27th July 2007, please find attached to this declaration a redacted copy of a letter received from Stephen Hallahan's employer, Cross VetPharm Group Limited indicating that Mr Hallahan's employer had asked him to sign the Power of Attorney form. I understand this letter to mean that the inventor's business address is current and that although the application papers were received and signed for by someone other than the inventor, the papers have been given to the inventor for signature and he has been directed to sign them by his employer.

I still have not received the signed documentation from Stephen Hallahan. I therefore assumed that Mr Hallahan has refused to join in the application papers.

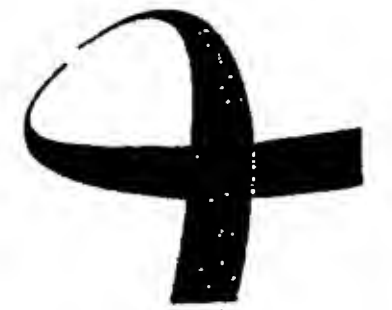
I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that wilful false statements and the like so made are punishable by fine or imprisonment, or both under Section 1001 of Title 18 of the United States Code and that such wilful false statements may jeopardise validity of the application or any patent issued thereon.

Signed:


Christina Gates Ph.D
Managing Partner
Tomkins & Co.

Dated:





Private & Confidential

**Fax Transmission: 660 69 20
& Postal Service**

**CROSS VETPHARM
GROUP LIMITED**

**Ms. Christina Gates
Managing Partner
Tomkins & Co
Patent and Trade Mark Attorneys
5 Dartmouth Road
Dublin 6**

23rd July 2007

**Re: United States of America Patent Application No 10/576,010 – Teagasc –
National Dairy Products Research Centre and University College, Cork –
National University of Ireland**

Dear Christina,

I refer to your letter of 15th June 2007 in relation to the above matter.

In view of the presumed deadline in the United States of America, I have requested Steve Hallahan to sign a modified version of the United States of America Power of Attorney Form. I understand that this will allow the United States of America patent application to proceed.

The issue of an assignment is not, I understand, critical at this stage.

If you should have any questions, please do not hesitate to contact me.

Paul Brady

Yours sincerely,

For and on behalf of Cross Vetpharm Group Limited


PD Brady
Director &
Group Company Secretary

23 / July / 2007

Fax transmission: 025 422 22
& Postal Service

Copy: Dr. Paul Ross
National Dairy Products Research Centre
Teagasc – Irish Agriculture and Food Development Authority
Moorepark
Fermoy
Co. Cork